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08/615, 724 03/14/96 SOKOLOV

EXAMINER

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BSM1/0708

CHURCH, C

ART UNIT

PAPER NUMBER

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DATE MAILED:

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 29-42 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 29-42 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

The amendment filed March 14, 1996 is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure comprises the additions to line 16 of page 4. Applicant is required to cancel the new matter in the response to this Office action.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the invention as it is now claimed. While page 4 of the specification explains that the grid frame may be monolithic, there is no teaching in the original disclosure that the main body is "monolithic" or that the main body is "monolithic perforated plate".

Claims 29-32 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 29 and 31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 contradicts the disclosure on reciting that the partitions are nondiagonal with respect to the longitudinal side since the partitions are, in fact, disclosed as diagonal (slanted). Claim 31 is not meaningful since the source is not claimed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41 and 33 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Caldwell.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same

person.

Claims 29-32 and 34-36 rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell. Caldwell teaches a reciprocating antiscatter grid comprising a frame 28 and cells formed by x-ray opaque partitions 29 which are angled with respect to the sides of the grid and direction of motion so as to eliminate shadows of the partitions in the final image and which may either be parallel to one another or focussed on the x-ray source. See lines 27-35 of page 2 and 103-108 of page 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Caldwell frame with an x-ray absorbing covering in order to eliminate x-ray scatter therefrom.

Claims 37-39 are rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell in view of Millenaar. Caldwell fails to teach the use of cover plates on the end faces of his grid, but this is a common practice as shown by Millenaar, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Caldwell grid with such covers to protect it. Furthermore the use of evacuated holes would have been obvious to reduce x-ray absorption.

Claim 40 and 42 are rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell in view of Mattsson cited by applicant. Caldwell teaches a reciprocating antiscatter grid comprising a frame 28 and cells formed by x-ray opaque partitions 29 which are angled with respect to the sides of the grid and direction of

motion so as to eliminate shadows of the partitions in the final image. See lines 27-35 of page 2 and 103-108 of page 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to fabricate the Caldwell grid with partitions angled as taught by Mattsson in order to maximize performance as explained by Mattsson.

Claims 29-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending application Serial No. 583437. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Applicant's arguments filed August 28, 1995 have been fully considered but they are not deemed to be persuasive. It is noted that a broad interpretation of the term "diagonal" could be "slanted" or "oblique" and is not limited to 45° as argued by applicant.

Claim 37 does not recite that the end plates are hermetically

sealed as argued by applicant.

Contrary to applicant's arguments (bottom of page 14), none of the instant claims recites a planar grid, and Caldwell teaches in lines 103-108 of page 3 that his grid may be flat. Again contrary to applicant's assertions, Caldwell does not teach that the cells are filled with bakelite etc but only that they "may" be. Independent claims 33 and 41 fail to recite means for moving the grid at all, and that Mattsson's grid may have been moved obliquely with respect to a patient is not germane since applicant is not claiming a system but simply the grid per se. Furthermore the Caldwell grid is moved parallel to its longitudinal side.

While applicant asserts that there is no teaching in the references to combine prior art features, the hypothetical person of ordinary skill in the art may be motivated to combine prior art teachings by his own common sense and general knowledge. See for example:

In re Nilssen, 7 USPQ2d 1500, 1988

Milliken Research v. Dan River Inc, Federal Circuit, 1985

Ex parte Obiya, 227 USPQ 59, 1985

Ex parte Clapp, 227 USPQ 972,973, 1984

In re Keller, 208 USPQ 871, 1981

In re Jacoby, 135 USPQ 317, 1962

In re Sernaker, 217 USPQ 1.6, 1983 where the Court declared
The (district) court has said, and we agree, it is not necessary that the prior art suggests expressly or in so many words the "changes or improvements" the inventor has made. It is only necessary that he apply "knowledge clearly present in the prior art."

Applicant's arguments are largely based on limitations that

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are not claimed and on misrepresentations of that which is claimed and of that which is clearly taught by the prior art.

Any inquiry concerning this communication should be directed to Examiner Church at telephone number (703) 308-4861.

Craig E Church

CRAIG E. CHURCH
Senior Examiner
ART UNIT 2506